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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,781	02/18/2004	De-Sheng Tsai	9286.32	2750

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EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/780,781	Applicant(s) TSAI ET AL.	
	Examiner Elizabeth M. Cole	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 34-40 is/are pending in the application.
 4a) Of the above claim(s) 1-20 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-28 and 34-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/30/04</u> . | 6) <input type="checkbox"/> Other: ____ |

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1. Applicant's election with traverse of Group II in the reply filed on 12/22/05 is acknowledged. The traversal is on the ground(s) that the examiner has not shown that examining both groups would be a burden. This is not found persuasive because the search for the two groups is different and because the issues involved in determining patentability for a product versus a method will necessarily be different. Rejoinder will be considered at the time that a product claim is allowed.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 23, 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 23, it is not clear if Applicant intends to claim a nonwoven which comprises each of carded, spunbond, SMS and SMMS fabrics, or if the claim is intended as a Markush type claim. If a Markush type claim is intended, then the format is improper. With regard to claim 34, it is not clear how claim 34 further limits claim 21 since it does not add any additional structure to that which is set forth in claim 21. Reciting a product containing the elastic nonwoven of claim 21 does not seem to further limit the claim since the product could be the elastic nonwoven itself.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 21, 23-25, 34-39 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 09285490, (machine translation attached). JP '490 discloses an elastomeric nonwoven web comprising a bicomponent fiber which comprises polypropylene and an elastomeric component. See paragraph 0010-0014. The nonwoven can further comprise additional types of fibers including natural and synthetic fibers. See paragraphs 0025-0026. The nonwoven can be formed by melt spinning or by carding staple fibers. See paragraph 0027. The fabric can be thermally bonded. See paragraph 0028. The fabric can be incorporated into a variety of personal care articles including diapers. With regard to the particular uses set forth in dependent claims 34-39, since no structure is set forth in the claims, these limitations are taken as statements of intended use.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 09285490. JP '490 discloses an elastic nonwoven fabric as set forth above. JP '490 does not disclose the particular elongation and recovery set forth in claims 22 and 23. However, since JP '490 teaches the same structure, it is reasonable to presume that the material of JP '490 would necessarily have the same properties. With regard to the process limitations set forth in

claim 23, product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product - by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe , 227 USPQ 964, 966 (Fed. Cir. 1985).

Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983).

The use of 35 USC 102/103 rejections for product by process claim has been approved by the courts. "[T]he lack of physical description in a product - by - process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product - by - process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put

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before it and then obtain prior art products and make physical comparisons therewith."

In re Brown , 173 USPQ 685, 688 (CCPA 1972).

6. Claims 21, 22, 26-28 35-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Erdos et al, U.S. Patent Application Publication 2002/0056510.

7. Erdos et al discloses an elastic nonwoven fabric laminate. The nonwoven fabric can comprise polypropylene fibers, and may be spunbonded, or a thermally bonded carded nonwoven of staple fibers. See paragraph 0050 and claim 4. The fabric is bonded to an elastic film layer. The laminate is subjected to heat, pressure and tension in order to form the elastic fabric. The elastic fabric laminate has good CD elongation and recovery, with a CD elongation of at least 120% and recovery of at least 80% after elongation of 100%. See paragraph 0017, 0024, 0049, The fabric can be incorporated into a variety of personal care articles including diapers. With regard to the particular uses set forth in dependent claims 34-39, since no structure is set forth in the claims, these limitations are taken as statements of intended use. See paragraph 0058-0060.

8. Claim 23 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Erdos et al, U.S. Patent Application Publication 2002/0056510. Erdos et al discloses an elastic fabric laminate as set forth above. Erdos et al does not identically disclose the claimed processing parameters. However, as set forth above, product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Therefore, the burden is on Applicant to show that the processing differences result in an unobvious difference between the claimed invention and the invention of Erdos et al.

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9. Claims 21-28, 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdos et al, U.S. Patent Application Publication 2002/0056510 in view of JP 09285490. Erdos et al discloses an elastic fabric laminate as set forth above. Erdos et al differs from the claimed invention because it does not teach employing conjugate fibers in the nonwoven. JP '490 teaches that bicomponent fibers can be employed in forming elastic nonwovens comprising polypropylene. Bicomponent fibers are generally used to facilitate bonding due to the different melting points between the sheath and core. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed bicomponent fibers in the nonwoven of Erdos, motivated by the teaching of JP '490 that such fibers were useful in forming elastic nonwovens and by the expectation that the use of bicomponent fibers would facilitate bonding within the nonwoven while maintaining the strength of the fabric.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

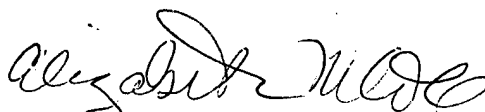
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

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A handwritten signature in cursive script, appearing to read "Elizabeth M. Cole".

Elizabeth M. Cole
Primary Examiner
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